

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/982,709 Confirmation No.: 8648
Applicant: Andrew C. Gilbert (deceased), et al.
Title: TWO-SIDED TRADING ORDERS
Filed: October 18, 2001
Art Unit: 3685
Examiner: John W. Winter

Atty. Docket: 01-1041
Customer No. 63710

AMENDMENT IN REPLY TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant replies to the Restriction Requirement of July 8, 2010 as follows. Kindly amend the application as follows.

PETITION FOR EXTENSION OF TIME

Applicant petitions for a five-month extension of time to reply to the Action of July 8, 2010, to and including January 10, 2011. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely. Kindly charge the petition fee to Deposit Account No. 50-3938, Order No. 01-1041.

AMENDMENTS TO THE CLAIMS begin on page 2 of this paper.

REMARKS/ARGUMENTS begin on page 10 of this paper.

AMENDMENTS TO THE CLAIMS

Kindly replace the claims as follows.

1. (Previously presented) A method comprising the steps of:
by a computer for a trader for use in an electronic trading system, presenting to the trader an order entry user interface, the computer being programmed:
to receive through the order entry user interface simultaneously as part of a single command from the trader, two orders for buying and/or selling an item, and
to receive a price spread between the prices for the two orders;
the electronic trading system being programmed to generate automatically a price for one or both of the orders based on the trader's received price spread; and
submitting the two orders into the electronic trading system to be matched against counterorders.
2. (Previously presented) The method of claim 1:
further comprising displaying current bid and offer data associated with the item, and
wherein receiving the bid command comprises receiving a selection of a piece of the bid and offer data displayed.
3. (Cancelled)
4. (Previously presented) The method of claim 2, wherein:
the current bid and offer data comprises a bid price for the item, and
receiving a selection of a price of the bid and offer data comprises receiving a selection of the bid price for the item.

5. (Previously presented) The method of claim 2, wherein:
the current bid and offer data is displayed on the order entry user interface on a screen display selected from the group consisting of a market cell, a spread sheet, a data window, an entry window, and a web page.

6-9. (Cancelled)

10. (Previously presented) The method of claim 1, wherein:
one of the orders is a bid to buy the item specifying a price; and
the other of the orders is an offer to sell the offer, at a the price generated automatically based at least on the price specified with the bid.

11. (Previously presented) The method of claim 10, further comprising the step of:
automatically displaying an interface screen in response to receiving of the bid command, the interface screen comprising at least one field for specifying a term of the offer to sell the item, at least one field of the interface screen populated with the at least one of a price and a size generated for the offer automatically.

12. (Previously presented) The method of claim 10, further comprising the step of:
automatically repositioning a pointing device pointer to be positioned over a button in the interface screen corresponding to the bid command.

13. (Previously presented) The method of claim 12, wherein the pointing device pointer is repositioned over a bid button in the interface screen.

14. (Currently amended) A method comprising the steps of:
displaying current bid and offer data regarding orders to buy and/or sell an item, the displaying being to a trader and performed by a trader computer of an electronic trading system, the system being programmed to match orders to buy and sell the item;
at the trader computer of the electronic trading system, receiving from the trader a selection of a piece of the bid and offer data;
displaying to the a trader at an order entry user interface that permits entry of a second order to buy or sell the item, the order entry interface providing fields ~~files~~ to specify terms of an offer to buy or sell the item, at least one field for specifying at least one term for the second order being populated with the selected piece of the first order, and at least one other field populated with the at least one of a price and a size generated automatically by the electronic trading system based on at least one of a price and a size for the order of the selected data piece and a pre-set spread amount.

15-16. (Cancelled)

17. (Previously presented) The method of claim 14, wherein:
the current bid and offer data comprises a bid price for the item, and
receiving a selection of a price of the bid and offer data comprises receiving a selection of the bid price for the item.

18. (Previously presented) The method of claim 14, wherein:
the first trading command entry interface is a screen display selected from the group consisting of a market cell, a spread sheet, a data window, an entry window, and a web page.

19-22. (Cancelled)

23. (Previously presented) The method of claim 14, wherein:
the bid to buy the item specifies a price; and
the price for the second order is generated automatically based at least on the price specified with the order of the selected data piece.

24. (Cancelled)

25. (Previously presented) The method of claim 14, comprising populating the at least one field for specifying at least one term for the bid to buy the item with a selected bid price.

26-29. (Cancelled)

30. (Previously presented) A method comprising the steps of:
by a computer for a trader for use in an electronic trading system, presenting to the trader a order entry user interface, the computer being programmed:

to receive through the order entry user interface simultaneously as part of a single command from the trader, a bid to buy and an offer to sell an item, and

to receive a price spread between the prices for the two orders;

the electronic trading system being programmed to generate automatically at least one of a price and a size for the bid to buy the item based on at least one of a price and a size for the offer to sell the item and a pre-set spread amount; and

in response to a single act of the trader, submitting the two orders into the electronic trading system to be matched against counterorders.

31. (Previously presented) The method of claim 30, further comprising:
displaying current bid and offer data associated with the item, wherein receiving the offer command comprises receiving a selection of a piece of the bid and offer data displayed.

32. (Cancelled)

33. (Previously presented) The method of claim 31, wherein the current bid and offer data comprises an offer price for the item, wherein receiving a selection of a price of the bid and offer data comprises receiving a selection of the offer price for the item.

34. (Previously presented) The method of claim 31, wherein:
the current bid and offer data is displayed in a screen display selected from the group consisting of a market cell, a spread sheet, a data window, an entry window, and a web page.

35-38. (Cancelled)

39. (Previously presented) The method of claim 30, wherein:
the offer to sell the item specifies a price and wherein the price for the bid is generated automatically based at least on the price specified with the offer.

40. (Previously presented) The method of claim 30, further comprising:
automatically displaying an interface screen in response to receiving of the offer command, the interface screen comprising at least one field for specifying a term of the bid to buy the item, the at least one field populated with the at least one of a price and a size generated for the bid automatically.

41. (Previously presented) The method of claim 30, further comprising automatically repositioning a pointing device pointer to be positioned over a button in an interface screen corresponding to the offer command.

42. (Previously presented) The method of claim 41, wherein the pointing device pointer is repositioned over an offer button in the interface screen.

43-105. (Cancelled)

106. (Previously presented) The method of claim 4, wherein
the order entry interface screen comprises at least one field for specifying at least one
term for a bid to buy the item and at least one field for specifying at least one term for an offer to
sell the item.

107. (Previously presented) The method of claim 106, comprising populating the at least
one field for specifying at least one term for the bid to buy the item with the selected bid price.

108. (Previously presented) The method of claim 106, comprising populating the at least
one field for specifying the at least one term for the offer to sell the item with the at least one of a
price and a size of the item generated for the offer automatically.

109. (Previously presented) The method of claim 106, comprising populating the at least
one field for specifying at least one term for the bid to buy the item with a price a predetermined
amount better than the selected bid price.

110. (Previously presented) The method of claim 106, the interface screen comprising at
least one price up button and at least one price down button for adjusting terms of at least one of
the bid and the offer.

111. (Previously presented) The method of claim 1, the bid to buy the item and the offer
to sell the item submitted simultaneously.

112. (Previously presented) The method of claim 33, comprising displaying an interface
screen comprising at least one field for specifying at least one term for the bid to buy the item
and at least one field for specifying at least one term for the offer to sell the item.

113. (Previously presented) The method of claim 112, comprising populating the at least one field for specifying at least one term for the offer to sell the item with the selected offer price.

114. (Previously presented) The method of claim 112, comprising populating the at least one field for specifying the at least one term for the bid to buy the item with the at least one of a price and a size of the item generated for the bid automatically.

115. (Previously presented) The method of claim 112, comprising populating the at least one field for specifying at least one term for the offer to sell the item with a price a predetermined amount better than the selected offer price.

116. (Previously presented) The method of claim 112, the interface screen comprising at least one price up button and at least one price down button for adjusting terms of at least one of the bid and the offer.

117. (Previously presented) The method of claim 30, the bid to buy the item and the offer to sell the item submitted simultaneously.

118. (Previously presented) The method of claim 1, wherein:
the order entry user interface is programmed to receive the two orders as counterpositions to each other.

119. (Previously presented) The method of claim 1, wherein:
the electronic trading system is further programmed to enter a first one of the orders into active market matching against counterorders substantially immediately, and
the electronic trading system is further programmed to hold a second of the two orders from market matching until the first order is executed, and when the first order is executed, then enters the second order into active market matching.

120. (Previously presented) The method of claim 1, wherein:

the electronic trading system is further programmed to enter both of the two orders into active market matching against counterorders substantially immediately when received from the trader.

REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of July 8, 2010 and respectfully requests reconsideration of the application.

I. The July 2010 paper fails to consider the substance of the claim language

Before amendment, claim 14 recited an “electronic trading system.” All electronic trading systems known to this attorney “match orders against counterorders.” If there are exceptions, they are too few to constitute a material difference. Thus, the distinction drawn in the Action is illusory. The paragraph at the top of page 3 of the Action fails to show a “materially different combination” and thus the restriction fails a showing of “independent and distinct” fails.

Nonetheless, the amendment to claim 14 now removes the distinction relied on in the Action, and the claims are no longer “independent and distinct” for restriction purposes.

II. The Action fails to use form paragraphs that were authorized as of July 2010

The Action uses an obsolete form paragraph, the (a) (b) (c) (d) (e) form at page 3. This form paragraph originated in memo from John Love to the examining corps on April 25, 2007. That memo became obsolete when the MPEP was revised without incorporating the Love criteria into the text. Further, in a Federal Register notice, *Request for Comments on Proposed Changes to Restriction Practice in Patent Applications*, 75 Fed. Reg. 33584 (June 14, 2010), the PTO noted that these two criteria were only “proposed” and “under consideration,” and are not currently available for use.

Paragraph 5 of the Action errs in only giving a laundry list of five possible grounds, without identifying which one is applicable, or identifying the facts or giving an explanation to support that ground. MPEP § 808.02 requires that “[T]he examiner, in order to establish reasons for insisting upon restriction, ***must explain*** why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must ***show by appropriate explanation*** one of”

three specific showings.¹ The July 2010 Action contains no such explanation. Without that showing, the July 2010 paper is incomplete, and raises no requirement to elect.

The Action uses an unauthorized short-cut. Form paragraph 8.15 requires one more sentence, which the Examiner cut (leaving the extra trailing period as evidence of an unauthorized edit). Examiners are not authorized to edit the restriction form paragraphs. The Action was not issued pursuant to authority delegated by the Office. No election is required.

III. The Action relies on an incorrect search classification

715/222 is not a correct search class designation. 715/222 is directed to “Subject matter wherein a form document* is generated.” 715/222 is nested within 715/221, “wherein the elements of data define specific locations reserved for entering data.” 715/221 is nested within 715/200, “Subject matter wherein elements of text-only or diverse media type data* are gathered, associated, created, formatted, edited, prepared, or otherwise processed to be presented or wherein the relationship between the elements in a document or portion thereof is defined.” Class 715 is directed to user interfaces. The searchable part of claim 14 does not relate to the user interface, it relates to trading. The best class/subclass for searching claim 14 is 705/37.

IV. Traverse under administrative law statutes

Applicant also traverses pursuant to 44 U.S.C. § 3507 (“An agency shall not conduct or sponsor the collection of information unless in advance of the adoption or revision ... the agency has...” followed the steps for obtaining White House approval), 44 U.S.C. § 3512, and 5 C.F.R. § 1320.6. The PTO neglected to follow the required steps to obtain approval for the Love memo.

Further, “the USPTO must engage in notice and comment rule making when promulgating rules it is otherwise empowered to make.” *Tafas v. Dudas*, 541 F.Supp.2d 805, 812, 86 USPQ2d 1623, 1628 (E.D. Va. 2008). The PTO has not observed the requirements of

¹ See also MPEP § 803(I)(B), § 803(II) ¶ 4, and § 806.01: “Examiners must provide reasons and/or examples to support conclusions” of “unduly extensive and burdensome search,” for example, by “appropriate explanation of separate classification, or separate status in the art, or a different field of search.”

the Administrative Procedure Act (APA) with respect to the Love memo, so it may not be enforced.

V. Provisional Election

If and only if the Examiner can and does cure all of the above defects in the next Office Action, applicant provisionally elects as follows. Applicant notes that all independent claims now recite a “trading system” that does matching of orders. The claims that fall within the group “matching orders against counter orders by a trading system” are claims 1-5, 10-18, 23-25, 30-34, 39-47, 52-54, and 106-120. Applicant provisionally elects that group. If no complete restriction requirement can be framed, all claims must be examined.

VI. Authorization for Email Communication and Conclusion

Applicant hereby authorizes the USPTO to communicate with any authorized representative concerning this application by electronic mail.

Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. For the entire pendency of this application, the Commissioner is authorized to charge any additional required fees (including all extension of time fees), or credit any overpayment, to Deposit Account No. 50-3938, Order No. 01-1041.

Respectfully submitted,

BGC PARTNERS, INC.

Dated: January 10, 2011

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